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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,104	10/16/2001	Gerald Huber	401301/A.BRAUN	6078

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EXAMINER

JOYNES, ROBERT M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 04/07/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/890,104

Applicant(s)

HUBER ET AL.

Examiner

Robert M. Joynes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Receipt is acknowledged of applicants' Response filed on September 29, 2003.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 7, 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 18 recite that the polymer used in the composition is swellable and/or erodible in gastric and/or intestinal fluids. While this terminology is clear on its face from reading Claims 3 and 18, when read with the claim from which it depends, Claim 1, it becomes unclear. Claim 1 recites that the polymer incorporated in the core and/or the coating is insoluble in the gastric and/or intestinal fluids. It is unclear how the polymer can be insoluble yet erode in the same gastric and/or intestinal fluids. Clarification is suggested.

Claim 7 recites that the sphericity of the particles is less than 0.9, *according to Wadell*. It is unclear what the 0.9 represents without any units or what standard the Wadell standard is. Clarification and/or evidence of the Wadell standard for sphericity is suggested.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 and 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masterson et al. (US 5580580). Masterson teaches a particulate formulation comprising a core that contains an active agent and water insoluble polymer, both in the core and coated on the core (Col. 2, line 51 – Col. 3, line 22; Col. 4, line 40 – Col. 5, line 16). The core comprises a homogenous blend of active agent and polymer wherein the completed active cores have a particle size of 0.4-1.6 mm (Col. 6, lines 16-42). The completed cores can be incorporated into compressed tablets along with tableting excipients such as microcrystalline cellulose (Col. 9, lines 56-62).

Masterson does not expressly teach the same exact particle size range and concentrations for the polymers. Further, Masterson is silent as to the porosity and sphericity of the particles taught by the reference.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to prepare coated particles that comprise an active agent with insoluble polymers both in the core as a homogeneous mixture and coated onto the

core. With respect to the claimed concentrations and particle sizes, absent a clear showing of criticality, the determination of particular concentrations and particle size are within the skill of the ordinary worker as part of the process of normal optimization.

With regard to porosity and sphericity, the reference is silent to these limitations. However, the Office does not have the facilities for examining and comparing applicant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed products are functionally different than those taught by the prior art and to establish patentable differences. See *Ex parte Phillips*, 28 U.S.P.Q.2d 1302, 1303 (PTO Bd. Pat. App. & Int. 1993), *Ex parte Gray*, 10 USPQ2d 1922, 1923 (PTO Bd. Pat. App. & Int.) and *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977). The reference teaches the same general components claimed by the Applicants, therefore, the burden is shifted to the Applicants to prove that the cited reference does not possess the claimed characteristics.

One of ordinary skill in the art would have been motivated to do this to prepare a tablet formulation that provide long-term (once-a-day) administration of the active agent wherein the active agent can be tolerated by the user for the long-term period.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masterson et al. (US 5580580) in combination with Malmqvist-Granlund et al. (US

5178868). The teachings of Masterson are discussed above. Masterson does not teach all the active agents recited in instant claims 8-10.

Malmqvist-Granlund teaches that various active agents can be incorporated into core formulations (Col. 5, lines 1-34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to prepare tablets comprising active agent cores that can comprise various active agents and an insoluble polymer that are also coated with an insoluble polymer.

One of ordinary skill in the art would have been motivated to do this to prepare long-term formulations for various drugs with the same expected results that the active will be released over an extended period of time (once-a-day type formulations) and the active agent be administered will be tolerable to the user of the formulation.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

This action is deemed non-final due to the new grounds for rejection.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Joynes whose telephone number is (571)

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272-0597. The examiner can normally be reached on Mon.-Thurs. 8:30 - 6:00, alternate Fri. 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Joynes  
Patent Examiner  
Art Unit 1615

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
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